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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,530	10/24/2000	Lars Wahlberg	19313-004 (NS-4)	4889

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EXAMINER
HAYES, ROBERT CLINTON

ART UNIT	PAPER NUMBER
1647	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/696,530	Applicant(s) WAHLBERG ET AL.
	Examiner ~~Elizabeth C. Kemmerer~~ Robert Hayes, Ph.D.	Art Unit ~~1646~~ 1647

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 August 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-56* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-56* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-23 and 42-56, drawn to GFAP$^+$ neuronal cell culture and method of making same, classified in class 435, subclass 325, for example.

II. Claims 24-26, drawn to method of producing non-neuronal cells in culture, classified in class 435, subclass 377, for example.

III. Claims 27-31, drawn to method of propagating a genetically modified GFAP+ neuronal cell, classified in class 435, subclass 455, for example.

IV. Claims 32-33, drawn to method of producing a genetically modified non-neuronal cell, classified in class 435, subclass 455, for example.

V. Claim 34, drawn to method of transplanting cells to a patient, classified in class 424, subclass 520, for example.

VI. Claims 35 and 36, drawn to method of transplanting transformed cells to a patient, classified in class 514, subclass 44, for example.

VII. Claims 37-40, drawn to methods of determining the effects of an agent on a cell culture, classification dependent upon structure of the agent.

VIII. Claim 41, drawn to a cDNA library, classified in class 536, subclass 23.1, for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and each of II, III, IV, V , VI and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the $GFAP^+$ neuronal cell culture can be used to produce proteins in vitro on its own without first differentiating the cells to non-neuronal form or transformed.

Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because these products constitute patentably distinct inventions for the following reasons. Groups I and VIII are directed to products that are distinct both physically and functionally, are not required one for the other, and are therefore patentably distinct. The cDNA library must be made from the cell culture of claim 1 (Group I); however, the cell culture can be used in materially different processes, such as to produce proteins in vitro, or as cell transplant material.

Similarly, although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different methods, restriction is deemed to be proper because these methods appear to constitute patentably distinct inventions for the following reasons: Groups II-VII are directed to methods that are distinct both physically and functionally, and are not required one for the other. Invention II requires search and consideration of differentiation of cultured cells, which is not required by any of the other groups.

Invention III requires search and consideration of genetically modifying cultured cells, which is not required by any of the other groups. Invention IV requires search and consideration of genetically altering neuronal cells and differentiating same, which is not required by any of the other groups. Invention V requires search and consideration of cell transplantation, which is not required by any of the other groups. Invention VI requires search and consideration of gene therapy, which is not required by any of the other groups. Invention VII requires search and consideration of screening for agents, which is not required by any of the other groups. Therefore, a search and examination of all of the methods in one patent application would result in an undue burden, since the searches for the methods are not co-extensive, the classification is different, and the subject matter is divergent.

Inventions VIII and each of II-VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the inventions are not disclosed to be capable of use together and have different modes of function. Specifically, none of methods II-VII require a cDNA library as claimed in VIII.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, separate search requirements, and/or different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Hayes, Ph.D., whose telephone number is (703) 305-3132.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, Ph.D., can be reached on (703) 308-4623. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Elizabeth C. Kemmerer

ECK
July 1, 2002

ELIZABETH KEMMERER
PRIMARY EXAMINER